

Appl. No.: 10/658,446
Art Unit: 3711 Docket No.: B03-58
Reply to Office Action of October 18, 2004

REMARKS

Claims 1 and 7-10 and 13-18 appear in this application for the Examiner's review and consideration.

Claim 1 has been amended to include the recitations of claim 7 including the thin dense layer and its thickness, and claim 7 has been amended to further narrow the thickness of the thin dense layer. Support for the claim amendments may be found at least in the specification at page 11, lines 11-14. No new matter has been added by these amendments.

Rejection Over U.S. Patent No. 5,952,415

Claims 1, 7-10 and 13-18 were rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,952,415 to Hwang *et al.* ("Hwang"). Hwang is generally directed to a golf ball which has good spin property and long carry.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Contrary to the Examiner's assertion, the cited reference does not disclose the thickness of the thin dense layer as now recited in claim 1. In the Office Action, the Examiner stated that layer 5c in Example 5 in Table 3, has a diameter of 37.5mm giving it a thickness of 1.25mm. Applicants disagree. No thickness of the layers in Example 5, or any of the other Examples, is less than 2.5mm. The thickness of layer 5c is determined by the layer's diameter of 37.5mm minus the diameter of the core of 35mm. Thus, the layer of 5c has a thickness of 2.5mm. Hwang simply does not disclose or suggest a thin dense layer in the thickness of from about 0.025mm to about 1.27mm as recited in amended independent claim 1.

Thus, amended independent claim 1 is patentable over the cited art. As such, dependent claims 7-9, which depend from independent claim 1, should be patentable for at least the same reasons set forth above.

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The Examiner also rejected independent claim 10 over Hwang. The Examiner states that the compression and specific gravity recited in claim 10 are inherent in the structure of Hwang. Applicants disagree. The Examiner must show how Hwang necessarily results in the claimed recitations. According to MPEP § 2112, “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993).” (MPEP § 2112, p. 54). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.’ *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).” (MPEP § 2112, p. 55).

Applicants submit that the structure of the core of Hwang would not necessarily result in a core having a compression and specific gravity within the claimed ranges. Even assuming some of the materials of the cores are the same, which Applicants do not concede, properties such as compression and specific gravity are dependent on numerous different factors, including how the material is made, the size of the core, and the fillers and their amounts in the cores. Differences in these and other factors will result in different values for compression and/or specific gravity for the core. Thus, Applicants submit that Hwang does not inherently teach the claimed values for compression and specific gravity. Moreover, although Hwang discloses golf balls having a compression from 87 to 107, this does not necessarily teach or suggest cores having a compression from about 10-60.

Additionally, Applicants submit that Hwang does not disclose or suggest the claimed highly neutralized polymers. Although Hwang does state that the ionomers may be partly or all neutralized, one of ordinary skill in the art is well aware that those available at the time of filing the Hwang application were only 70% neutralized. Applicants defined highly neutralized polymers in their specification as those disclosed in WO/0023519 and WO/0129129. Hwang does not disclose or suggest the highly neutralized polymers recited in independent claim 10.

Thus, for at least the above reasons, independent claim 10 is believed to be patentable over the cited art.

As discussed above with regard to the thickness of the thin dense layer, claim 16 is not disclosed by Hwang. In the Office Action, the Examiner stated that layer 5c in Example 5 in Table 3, has a diameter of 37.5mm giving it a thickness of 1.25mm. Applicants disagree. The thickness of layer 5c is determined by the layer’s diameter 37.5mm minus the diameter of the core 35mm.

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Thus, the layer of 5c has a thickness of 2.5mm. Hwang simply does not disclose or suggest a thin dense layer in the thickness of from about 0.025mm to about 1.27mm as recited in dependent claim 16.

Claims 13-15 and 17-18 depend from independent claim 10 and are patentable for at least the same reasons set forth above.

The rejection under 35 U.S.C. § 103(a) is believed to have been overcome for at least the above reasons. Applicants respectfully request reconsideration and withdrawal thereof.

Conclusion

Based on the remarks set forth above, Applicants believe that all of the rejections have been overcome and the claims of the subject application are in condition for allowance. Should the Examiner have any further concerns or believe that a discussion with the Applicants' attorney would further the prosecution of this application, the Examiner is encouraged to call the attorney at the number below.

No fee is believed to be due for this submission. However, should any required fees be due, please charge them to Acushnet Company Deposit Account No. 502309.

Respectfully submitted,

1/18/05
Date


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